

REMARKS

This is a Response to the Office Action mailed October 19, 2005, in which a three (3) month Shortened Statutory Period for Response has been set, due to expire January 19, 2006. Nine (9) claims, including three (3) independent claims, were paid for in the application. Claims 1, 7, and 8 are currently amended. Claims 4-6 and 9 are currently canceled. New claims 10-11 have been added. No new matter has been added to the application. The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090. Upon entry of the amendments herewith, claims 1-3, 7-8, and 10-11 remain pending.

1. Request for Continued Examination

In accordance with 37 U.S.C. 1.114, a Request For Continued Examination (RCE) is filed concurrently with this Amendment so that the Office Action mailed October 19, 2005 is effectively made non-final. Under 37 U.S.C. 1.114, the effect of the RCE, which makes the instant Office Action non-final, is to cause examination of the instant application to remain open. Accordingly, amendments and new claims submitted herein are to be entered as a matter of right, and each claim is entitled to continued examination, particularly with respect to the responses provided herein.

2. Rejections Under 35 U.S.C. § 102(b)

In the Office Action, claims 8 and 9 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by *Ahn et al.* (U.S. Patent No. 6,346,367), hereinafter *Ahn*. For a proper rejection of a claim under 35 U.S.C. Section 102, the cited reference must disclose all elements/features/steps of the claim. See, e.g., *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988).

a. Claim 8

Applicants respectfully submit that independent claim 8, as amended, is allowable for at least the reason that *Ahn* neither discloses nor suggests that an exposed region is continuously and spirally formed on a photoresist-coated glass board by intermittently projecting a first laser beam for forming a groove onto the photoresist-coated glass board and intermittently projecting a second laser beam for forming land pre-pits in synchronism with blocking the first laser beam onto the photoresist-coated glass board so that a spot of the first laser beam is located on the inner circumference side of the photoresist-coated glass board and a spot of the second laser beam is located on the outer circumference side thereof. Thus, *Ahn* does not anticipate claim 8, and the rejection should be withdrawn.

b. Claim 9

Claim 9 is canceled without prejudice, waiver, or disclaimer, and therefore, the rejection to this claim is rendered moot. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the canceled subject matter to the public.

3. Rejections Under 35 U.S.C. § 103(a)

In the Office Action, claims 1-7 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Ahn* further in view of *Brueck et al.* (U.S. Patent No. 6,320,648), hereinafter *Brueck*. It is well-established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

a. Claim 1

Applicants respectfully submit that independent claim 1, as amended, is allowable for at least the reason that the proposed combination of *Ahn* in view of *Brueck* does not disclose, teach, or suggest at least the feature of “a spot of the first laser beam is located on the inner circumference side of the photoresist-coated glass board and a spot of the second laser beam is located on the outer circumference side thereof” as recited in claim 1. *Ahn* neither discloses nor suggests that an exposed region is continuously and spirally formed on a photoresist-coated glass board by intermittently projecting a first laser beam for forming a groove onto the photoresist-coated glass board and intermittently projecting a second laser beam for forming land pre-pits in synchronism with blocking the first laser beam onto the photoresist-coated glass board so that a spot of the first laser beam is located on the inner circumference side of the photoresist-coated glass board and a spot of the second laser beam is located on the outer circumference side thereof. Further, *Brueck* fails to disclose, teach, or suggest at least the above-recited feature of claim 1.

Since neither *Ahn* or *Brueck* disclose, teach, or suggest at least the above-recited feature of claim 1, the proposed combination of *Ahn* in view of *Brueck* fails to disclose, teach, or suggest at least the above-recited feature of claim 1. Therefore, a *prima facie case* establishing an obviousness rejection by *Ahn* in view of *Brueck* has not been made. Thus, claim 1 is not obvious under proposed combination of *Ahn* in view of *Brueck*, and the rejection should be withdrawn.

b. Claims 2, 3, and 7

Because independent claim 1 is allowable over the cited art of record, dependent claims 2, 3, and 7 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that the dependent claims 2, 3, and 7 contain all features/elements of independent claim 1. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection to these claims should be withdrawn.

c. Claims 4-6

Claims 4-6 are canceled without prejudice, waiver, or disclaimer, and therefore, the rejection to these claims are rendered moot. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the canceled subject matter to the public.

4. Newly Added Claims

Newly added claims 10-11 are based on subject matter that is explicit and/or inherent within the description of the specification and/or the drawings. Applicants submit that no new matter has been added in the new claims 10-11, and that new claims 10-11 are allowable over the cited prior art. Therefore, Applicants request the Examiner to enter and allow the above new claims.

5. Conclusion

In light of the above amendments and remarks, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that all pending claims 1-3, 7-8 and 10-11 are allowable. Applicants, therefore, respectfully request that the Examiner reconsider this application and timely allow all pending claims. The Examiner is encouraged to contact Mr. Armentrout by telephone to discuss the above and any other distinctions between the claims and the applied references, if desired. If the Examiner notes any informalities in the claims, he is further encouraged to contact Mr. Armentrout by telephone to expediently correct such informalities.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Application No. 10/691,851
Reply to Office Action dated October 19, 2005

All of the claims remaining in the application are now clearly allowable.

Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

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